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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/727,248
Filing Date: November 29, 2000
Appellant(s): LEE, CHRISTOPHER A.

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GROUP 3700

Christopher A. Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 13, 2007 appealing from

the Office action mailed November 13, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The brief identifies ODS Properties, Inc, the assignee of rights in the present application as the party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. Claims 1-46 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Tulley et al.	US 6,688,976 B1	February 10, 2004
Stronach	WO 2000/67215 A1	November 9, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stronach (WO 00/67215) in view of Tulley et al (US 6,688,976).

Claims 1-46: Stronach discloses that upon actuation of the quick pick button the wagering terminal automatically selects racing candidates based on various algorithms (Pg. 10:21-29). Each time the quick pick button is actuated the wagering terminal selects a different set or arrangement of racing candidates based on different algorithms within the processor program. The player can continue to press the button until the candidates selected are unacceptable (Pg.

15:10-15). This is interpreted as a random means of automatically selecting candidates. Random number generators are well known in the art as a means of automatically selecting a random outcome or event. Such generators randomly select numbers based on some type of algorithm. Stronach discloses the use of a network and the Internet and the communication may be wired or wireless. Stronach discloses various types of racing information that can be displayed to the player and that the communications network may be wired or wireless systems using a telecommunications or cable network, which means phone or cable (Pg. 6-7). Stronach further discloses a betting card and an account manager in detail and viewing race events at more than one track and future race events (Pgs. 8-15). A detailed reading of Stronach by an artisan of ordinary skill would teach all of the claimed invention, except explicitly a random number generator means for automatically selecting candidates or racers located remotely from the wagering terminal or at a host location. Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race (Col. 21:42-53). Tulley discloses that

additionally the player can request that his/her selections be associated with a limited number of occurrences e.g. the randomly generated combination only occurs a certain amount of times. It would have been obvious to one of ordinary skill at the time of the invention to modify the wagering system of Stronach with the random "quick pick" number generated application at the host system of Tulley et al. Such a modification would provide an alternative and/or equivalent random means of automatically selecting candidates for the player in the event that the player is indecisive about what selections to make.

(10) Response to Argument

Appellant argues that the two motivations cited by the examiner are insufficient to maintain the obviousness 35 U.S.C. 103(a) rejection.

A. Tulley Does Not Disclose that the "Quick Pick" feature May Be Used with Pari-mutuel Racetrack Wagering Argument.

Appellant argues that Examiner misinterprets the "Quick Pick" feature being applied to Pari-mutuel racing. However, Examiner respectfully disagrees for the following reasons:

Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate

a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race (Col. 21:42-53).

More specifically, Tulley discloses that, "Although many embodiments described above are directed to pari-mutuel lotteries, the present invention may also be used with respect to, for example, pari-mutuel racetrack betting. For example, some types of racetrack bets require that a player select, in order, the top three horses that will win a race. According to an embodiment of the present invention, a player may also request that his or her selections be associated with a limited number of occurrences (e.g., that his or her selections be unique). According to other embodiments, a player may be assured that his or her selections in a sporting wager (e.g., a college basketball playoff tree) will be associated with a limited number of occurrences. (Col. 21:40-53)"

When interpreting the above passage, the examiner concludes that the statement "the present invention may also be used with respect to, for example, pari-mutuel racetrack betting" clearly encompasses the "invention" previously disclosed in its "entirety" (**including the disclosed "quick pick" feature within the pari-mutuel lottery aspect of the prior art**) and not limited to a player requesting that their selections be "associated with a limited number of occurrences (e.g., that his or her selections be unique)." Furthermore the above passage states, "a player **may also** request that his or her selections be associated with a limited number of occurrences (e.g., that his or her selections be unique)." The terms "may also" makes the limited occurrences feature an

additional feature and not a limiting feature. In summary Examiner contends that the prior art of Tulley provides enough disclosure that one of ordinary skill in the art would apply the "Quick Pick" feature disclosed towards pari-mutuel racetrack betting.

B. One Skilled in the Art Would Have No Motivation to Combine Stronach and Tulley in the Way Proffered by the Office Action Argument.

Appellant respectfully disagrees with Examiner's motivation to combine the references, which states, "Such a modification would provide an alternative random means of automatically selecting candidates for the player in the event that the player is indecisive about what selections to make." Appellant states, "Stronach already includes a means for automatically selecting candidates." Appellant further states, "the deterministic algorithms already provided in Stronach's wagering terminals are perfectly suitable for selecting racing candidates as they are based on handicapping data of the candidates." Examiner agrees that that Stronach does disclose a automatic means of selecting racing candidates, wherein various algorithms corresponds or generates various sets of candidates. Each time the selection button is actuated a different algorithm is used to determine a new random set of candidates (Pg. 10:20-30). The Examiner interprets this process to require or imply some form of a random number generator means. For example, if there are 10 algorithms used to generate different sets of candidates than the system has to randomly designate which algorithm to use (1 to 10) each time the select button is actuated. Furthermore, each algorithm would have to randomly designate or

select different candidates from a set of candidates (for instance 1 to 10) or

designate the order based on the type of wager (Stronach discloses wagers such

as "Pick A Winner", "Pick Two Any Order", "Pick Two Exact Order", etc (Pg. 9:5-

10)). The above implies that some type of random number generator means

would have to be used, but does not explicitly disclose a "random number

generation" means. However, it is clear that Stronach provides a type of random

automatic application means of selecting racing candidates, but for purposes of

prosecution Examiner had to find further evidence of a "random-number

generation" application, which is well known in the art. Tulley discloses a lottery

system that comprises of a controller (host system) networked to remote

terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player

via the player device, the controller implements a "quick pick" application that

randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If

the initial randomly selected numbers are deemed unacceptable (the

combination repeats elsewhere) the controller can regenerate a new selection

set (Col. 7:55-65). At least in the above regard Appellant does not argue the

invention of Tully teaching a random number generation application.

Furthermore, Tulley discloses that such a system can be used for pari-mutuel

horse racetrack betting where the player has to select in order the top three

horses that will win a race (Col. 21:42-53). Based on at least this disclosure in

regards to Tulley's system being implemented in horse race track betting,

Examiner contends that Tulley teaches an equivalent or suitable means of

automatically selecting race candidates. Furthermore, both references are the

same field of endeavor and are both drawn towards providing a player or user

with an automatic means of generating quick picks or candidates for a race.

Random number generators are well known in the art for providing random

scenarios to players, who choose not to or prefer not to determine outcomes

whether for a lottery, sporting event, or racing event. It would have been obvious

to one of ordinary skill at the time of the invention to substitute and/or modify the

random selection means of Stronach with the random number generation means

of Tulley to provide predictable results. Therefore, Examiner respectfully

contends that one skilled in the art would be motivated to substitute a random

selection means for another random selection means and/or combine teachings

of random selection means for purposes of providing predictable results such as

randomly selecting racers/candidates for a player.

C. One skilled in the Art Would Not Find It Obvious To Combine

Stronach and Tulley To Achieve Appellant's Claimed Invention Argument

In response to appellant's argument that there is no suggestion to

combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to

do so found either in the references themselves or in the **knowledge generally**

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992).

Appellant respectfully argues that there is no reason why one skilled in the art would incorporate Tulley's random "quick pick" process into Stronach's wagering terminals. Appellant states, "Stronach's automatic runner selection algorithms….use different weighting of handicapping data to automatically select racing candidates." Furthermore, that "Stronach's runner selection algorithms select runners based on known information that can be useful in to determining which runner is more likely to win." Appellant discloses in regards to Tulley that "Lottery games are random events. Each number has equal odds of being selected. Accordingly, one of ordinary skill in the art would not find it obvious to apply such a random selection process from that has equal odds to a race where each runner typically has different odds." Examiner respectfully disagrees with this interpretation of Tulley. Tulley et al. discloses a lottery system that comprises of a controller (host system) networked to remote terminals or player devices (Col. 11:20-30 & 52-60). If requested from the player via the player device, the controller implements a "quick pick" application that randomly generates lottery numbers for the player (Col. 5:1-9; Col. 16:57-67). If the initial randomly selected numbers are deemed unacceptable (the combination repeats elsewhere) the controller can regenerate a new selection set (Col. 7:55-65). Tulley discloses that such a system can be used for pari-mutuel horse racetrack betting where the player has to select in order the top three horses that will win a race. Tulley discloses that additionally the player can request that his/her selections be associated with a limited number of occurrences e.g. the randomly generated combination only occurs a certain amount of times (Col. 21:42-53).

When considering these factors applied to a pari-mutuel race game as disclosed

by Tulley, the random number generator would have to encompass those sets of

chosen candidates who have a limited number of occurrences. For example, if a

set of candidates selected by a first player is associated with only 1 occurrence in

the racing game. Then the odds of the random number generator generating a

particular candidate or set of candidates is limited, when considering that

generator and/or can only have one occurrence of the already chosen.

Therefore, the "quick pick" feature of Tulley uses weighted variables such as the

one above for randomly determining racing candidates. Therefore, the Tulley

reference would not be counterintuitive. Furthermore, the examiner interprets the

automatic selection means of Stronach to require or imply some form of a

random number generator means. For example, if there are 10 algorithms used

to generate different sets of candidates than the system has to randomly

designate which algorithm to use (1 to 10) each time the select button is

actuated. Furthermore, each algorithm would have to randomly designate or

select different candidates from a set of candidates (for instance 1 to 10) or

designate the order based on the type of wager (Stronach discloses wagers such

as "Pick A Winner", "Pick Two Any Order", "Pick Two Exact Order", etc (Pg. 9:5-

10)). The above implies that some type of random number generator means

would have to be used, but does not explicitly disclose a "random number

generation" means. However, it is clear that Stronach provides a type of random

automatic application means of selecting racing candidates. Examiner contends

that random number generators are well known in the art and Tulley illustrates an

example of such that can be applied to horse racing. Examiner contends that

both Stronach and Tulley are drawn towards the same field of endeavor (horse

racing) and both references are drawn towards providing a player or user with an

automatic means of generating quick picks or candidates for a race. At least for

the above reasons, one skilled in the art would be motivated to combine

Stronach and Tulley.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner

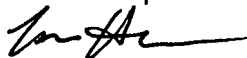in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be
sustained.

Respectfully submitted,

Tramar Harper　　　　　　　Patent Examiner　　Technology Center 3700
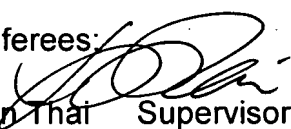
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